

RESPONSE TO OFFICE ACTION DATED SEPTEMBER 26, 2002
REMARKS

This is in response to the Office Action dated September 26, 2002. Applicant thanks the Examiner for indicating that claims 1-37 are allowed. As best understood, claims 38-59 are rejected on two grounds: (1) for improperly seeking claims as broad or broader than those claims previously canceled, an act barred by the recapture rule, and (2) for "improperly broadening the claims by removing the process limitation of step c) of claim 1 [while lacking] support in the disclosure where step c) is omitted."

I. THE RECAPTURE RULE IS IRRELEVANT HERE

The patent for which reissue is sought, U.S. Patent No. 5,840,249, had only one amendment, in which the terms "process" or "product" were substituted for the term "invention". Applicant respectfully submits that no relevant coverage was given up by this amendment and the recapture rule does not apply. This is supported by the Examiner's failure to identify any claims in the reissue application to which this rejection applies. Thus, the recapture rule does not apply to claims 38-59.

II. CLAIMS 38-59 DO NOT IMPROPERLY BROADEN THE ORIGINAL CLAIMS

In rejecting claims 38-59 as improperly broadened under 35 U.S.C. § 251, the Examiner argues that "The disclosure recites step c) which is critical (see col. 5. lines 31-67, bridging col. 6, lines 1-16)." However, step c) is *not* critical because (1) the patent does not describe it as critical and, indeed, (2) the specification itself indicates that the invention may be achieved without practicing step c).

A. THE PATENT DOES NOT ESTABLISH THE CRITICALITY OF CITRIC ACID

The Federal Circuit has found that an element is not "critical" in the context of a reissue application when "[n]o prior art was distinguished from and no rejection was overcome on the

basis of the [element]. Most importantly, one skilled in the art would readily understand that in practicing the invention [the element] is unimportant. . . . “ *In re Peters*, 723 F.2d 891, 893 (Fed. Cir. 1983). Inclusion of citric acid in the preferred embodiment does not mean that citric acid must be used at all times, or to carry out the invention. Claims may be broader than the specified or preferred embodiment. “As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed ‘less’ than he had a right to claim.” *In re Rasmussen*, 650 F.2d 1212, 1215 (CCPA 1981). Here, citric acid is not critical. As described below in more detail, citric acid is mentioned only once, in the Detailed Description of the Preferred Embodiment. The Summary of the Invention omits any reference to citric acid. No rejection was made with respect to citric acid, nor was any art cited by the Examiner relating to citric acid or otherwise. The claims were never amended to include citric acid nor was any prior art cited in which citric acid was used.

In the absence of any indication in the patent or prosecution history that citric acid is critical, this rejection should be withdrawn.

B. THE PATENT SUPPORTS THE NON-CRITICALITY OF CITRIC ACID

Besides the absence of any prosecution history with respect to citric acid, the patent specification actually shows that citric acid is not “critical” to the invention.

The portion of the specification relied on by the Examiner is captioned “Detailed Description of the Preferred Embodiment.” While Applicant agrees that the preferred embodiment indeed describes that “citric acid is added until the pH is 6.5 or below” (col. 6, line

6), Applicant disputes the criticality of this step because this single line is the *only* reference to the use of citric acid in the entire patent.

The "Summary of the Invention" describes the invention in several ways. As seen below, *none* of the several references in the Summary which identify the materials used to produce the preservative list citric acid as a component, let alone a critical component.

It is another object of this invention to utilize the filtrate of hydrous cellulose pulp having an unlimited shelf life as the water base to which potassium sorbate is added to provide a preservative that can be added to the slurry in the pulper or sprayed on wet lap pulp as a replacement for the poisonous biocides.

This invention further consist [sic] of a process in which the filtrate of hydrous cellulose pulp that has an unlimited shelf life is used as the water base for a liquid preservative that includes potassium sorbate.

This invention also includes a process for producing hydrous cellulose pulp in a process including wax paper and an emulsifier along with heat sufficient to melt the wax to thus provide a micro-molecular film on the fiber, filtering the resulting hydrous cellulose pulp and combining the filtrate with potassium sorbate to produce a non-toxic liquid preservative that can be sprayed on wet lap pulp and extend its shelf life.

It is a objective of this invention to produce a non toxic preservative through a process that includes the steps of repulping waxed paper in a process requiring an emulsifier and heat sufficient to melt the wax to thus provide a micro-molecular film on the fiber resulting from the repulping process, filter out the larger fiber strands, blend the filtrate such that the minute film coated particles become dispersed in the liquid and then combining the filtrate with a food quality preservative which results in a liquid preservative that can be sprayed on wet lap pulp which can then be used in processes for producing non toxic consumer products.

(Col. 3, lines 28-67, bridging col. 4, lines 1-20.)

Whether reissue claims can be supported by text describing objects of the invention has previously been addressed. In *Ex parte Froeschle*, the Patent Office Board of Appeals found that claims calling for at least one loudspeaker driver (with original claims calling for a plurality of drivers) were supported by the disclosure even though the multiple driver system was preferred,

in part because “the objects of the invention, at least in part, are applicable to either single or multiple driver systems.” *Ex parte Froeschle*, 223 U.S.P.Q. 190, 191 (PTO Bd. of App. 1984). See also, *In re Handel*, 312 F.2d 943, 136 U.S.P.Q. 460, 461 (CCPA 1963) (objects of the invention provide support for reissue claims); *In re Wesseler*, 367 F.2d 838, 840-41, 151 U.S.P.Q. 339 (CCPA 1966) (same). What is important is that the overall disclosure, including the summary of the invention, reasonably conveys that the use of citric acid is optional. *Peters*, 723 F.2d at 894.

In the present case, the specification makes clear that the invention includes processes in which citric acid is not used. The Summary of the Invention repeatedly describes the invention without reference to citric acid, while including other elements which are likewise included in Applicant’s pending claims. Although the specification discusses the use of citric acid in the preferred embodiment, the specification also conveys the concept that citric acid is not critical to practicing the invention by describing the invention without reference to the use of citric acid.

Specifically, as described above, the specification describes the invention as being “the filtrate of hydrous cellulose pulp having an unlimited shelf life as the water base to which potassium sorbate is added to provide a preservative” or “a process in which the filtrate of hydrous cellulose pulp that has an unlimited shelf life is used as the water base for a liquid preservative that includes potassium sorbate”, as well as the several other references set forth above.

Applicant is entitled to broaden the claims under these circumstances. The use of citric acid is never indicated -- either expressly or implicitly -- as “critical” to the claimed inventive preservative or process. Indeed, one skilled in the art who reads the *entire* specification, rather

than focusing on the preferred embodiment, would understand that the use of citric acid is not important to achieving the reduced decomposition of organic matter (see, e.g. claim 38).

Thus, all claims should be allowed.

III. THREE DEPENDENT CLAIMS SHOULD BE ALLOWABLE

Applicant believes that dependent claims 39, 50 and 55 were improperly rejected because they already call for citric acid. Specifically, the claims read:

39. The process of claim 38 further comprising a step of adding citric acid to the preservative in amounts to reduce the pH to 6.5 or lower.
50. The preservative of claim 45 further comprising citric acid sufficient to lower the pH to 6.5 or lower.
55. The product of claim 53 wherein the product further comprises sufficient citric acid to reduce the pH of the product to 6.5 or lower.

Thus, Applicant believes that it is inappropriate to assert that these three claims are improperly broadened.

For the foregoing reasons, claims 38-59 are each patentable, and a notice of allowance is requested for all claims 1-59. If, however, the Examiner believes that some of the claims are not allowable, she is invited to call Applicant's attorney to discuss any remaining issues.

Respectfully submitted,


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